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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,521	02/21/2002	Luciano Mondani	25-335	4703
23117	7590	06/07/2005	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			FOX, CHARLES A	
		ART UNIT	PAPER NUMBER	
			3652	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/078,521	MONDANI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Charles A. Fox	3652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 March 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 3-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 3-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 February 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The fork positioner is not able to move the second shoe into the same positions as the first shoe. While both may be placed proximate the center or the outside of the side shift frame, they cannot both be placed in the same first and second positions. In the art rejections of this claim the first positions are considered to be proximate the center of the side shift frame and the second positions are considered to be proximate opposite sides of the side shift frame in keeping with the disclosure of the instant invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Abels et al. In regards to claim 1 Abels et al. 4,125,199 disclose a sideshift assembly for a forklift comprising:

a carriage comprising a pair of vertical members (101) that are horizontally spaced;

a frame support member (104) secured transversely to said vertical members;

wherein said vertical members are movably secured in the mast of said forklift;

a side shift frame comprising an upper cross member (105a), a lower cross member (105) and at least 2 side members (107);

said upper cross member having a lower contact surface for sliding engagement with said frame support member (104);

side shift operator means (122) for causing lateral movement of said frame, wherein said means is slidably received in a portion of said frame support member.

Regarding claim 14 Abels et al. disclose a side shift assembly for a forklift comprising:

a carriage comprising a pair of vertical members (101) that are horizontally spaced;

a frame support member (104) secured transversely to said vertical members;

side shift operator means (122) for causing lateral movement of said frame, wherein said means is slidably received in a portion of said frame support member.

a side shift frame comprising an upper cross member (105a), a lower cross member (105) and at least 2 side members (107);

said upper cross member having a lower contact surface for sliding engagement with said frame support member (104);

wherein said upper member further comprises a planer front portion that protects the side shift operator means by preventing good carried by the forks to touch the front face (104a) of the support member which forms a portion of the side shift operator means.

In regards to claim 15 Abels et al. also discloses that the upper surface of the support member is convex and the lower surface of the upper cross member is concave, wherein said surfaces are slidably engaged with each other.

In regards to claims 16 and 17 Abels et al. further teach that said side shift frame is a quadrilateral shape with parallel side forming a rectangle.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21-24 and 3-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bostad et al. in view of Bolzoni. Regarding claims 21-24 Bostad et al. teach a sideshift assembly for a forklift comprising:

a carriage comprising a pair of vertical members (16) that are horizontally spaced;

a frame support member (33) secured transversely to said vertical members;

wherein said vertical members are movably secured in the mast of said forklift;

a side shift frame comprising an upper cross member (34), a lower cross member (28) and at least 2 side members (30,32);

said upper cross member having a lower contact surface for sliding engagement with said frame support member (33);

side shift operator means (52) for causing lateral movement of said frame, wherein said means is located in a portion of said frame support member. They do not teach the device as having a fork position device. Bolzoni DE 198 05 790 A1 teaches a fork positioner for a forklift truck, said positioner comprising:

first and second shoe members (14) adapted to slide horizontally along a sliding surface (33) of a side shift carriage;

each of said shoes adapted to receive a shank portion of a fork, said contact portion of said shoe being coplanar with a front face of a side shift frame;

said positioner adapted to move said shoes relative to each other such that the shoes are equidistant from the centerline of said side shift frame at all times;

wherein said shoes are proximate the center of the side shift frame when at a first position and proximate the edges of said side shift frame when at a second position. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by Bostad et al. with a fork positioner as taught by

Bolzoni in order to allow an operator to change the spacing of the forks from the operators seat while maintaining the operators view of the forks.

Regarding claims 4 and 7 Bolzoni further teaches the fork positioner for a forklift truck, said positioner comprising:

first and second shoe members (14) adapted to slide horizontally along a sliding surface (33) of a side shift carriage;

each of said shoes adapted to receive a shank portion of a fork, said contact portion of said shoe being coplanar with a front face of a side shift frame;

said positioner adapted to move said shoes relative to each other such that the shoes are equidistant from the centerline of said side shift frame at all times;

wherein the bottoms of said shoes slides on a lower sliding surface of the side shift frame. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by Bostad et al. with a fork positioner as taught by Bolzoni in order to allow an operator to change the spacing of the forks from the operators seat while maintaining the operators view of the forks.

In regards to claim 3 Abels et al. further teach that said side shift frame is rectangular.

In regards to claim 5 Abels et al. also teach that the upper surface of the support member is convex and the lower surface of the upper cross member is concave, wherein said surfaces are slidably engaged with each other. See figure 12.

In regards to claim 6 Abels et al. also teaches said upper cross member defines a planer portion overhanging a front side of said support member.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bostad et al. and Bolzoni as applied to claim 22 above, and further in view of German patent 200 20 292 U1. Bostad et al. and Bolzoni teach the limitations of claim 22 as above, they do not teach the side shift being driven by a pair of hydraulic cylinders. German patent '292 teaches a side shift carriage that uses two single action cylinder to move a side shift frame in one of two direction depending upon which cylinder is engaged, wherein each of the cylinders are sealed to prevent the escape of hydraulic fluid around the piston. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by Bostad et al. and Bolzoni with the cylinders as taught by the German '292 patent in order to simplify the hydraulic system by using single action cylinders to move the side shift frame.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bostad et al., Bolzoni and German '292 as applied to claim 8 above, and further in view of French Patent 76 02832. Bostad et al., Bolzoni and German '292 teach the limitations of claim 8 as above, they do not teach pads between the cylinders and the frame. French patent '832 teaches placing piston pads between a hydraulic cylinder and a side shift frame member. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by Bostad et al., Bolzoni and German '292 with piston pads as taught by French patent '832 to spread the load applied to the frame over a larger area.

Claims 11-13,25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bostad et al. and Bolzoni as applied to claims 22 and 23 above, and

Art Unit: 3652

further in view of Sorlie. In regards to claims 11 and 25 Bostad et al. and Bolzoni teach the limitations of claim 22 as above, Bolzoni further teaches the forks are maintained an equidistant length from the center line of the side shift carriage. They do not teach any particular type of drive system for the fork positioner. Sorlie US 5,190,436 teaches using hydraulic cylinders to position forks within a side shift frame. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by Bostad et al. and Bolzoni with the hydraulic cylinder taught by Sorlie in order to drive the fork positioner using a well known drive means as suggested by Bolzoni.

In regards to claims 12,13 and 26 Bolzoni further teaches that said center fork positioner is comprised of an upper chain and a lower chain forming a chain loop, wherein said chain loop is used to move said first and second shoes at the same time.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abels et al. as applied to claim 16 above, and further in view of German patent 200 20 292 U1. Abels et al. teach the limitations of claim 16 as above, they do not teach the side shift being driven by a pair of hydraulic cylinders. German patent '292 teaches a side shift carriage that uses two single action cylinder to move a side shift frame in one of two direction depending upon which cylinder is engaged, wherein each of the cylinders are sealed to prevent the escape of hydraulic fluid around the piston. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by Abels et al. with the cylinders as taught by the German '292 patent in order to simplify the hydraulic system by using single action cylinders to move the side shift frame.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abels et al. and German '292 as applied to claim 18 above, and further in view of French Patent 76 02832. Abels et al. and German '292 teach the limitations of claim 18 as above, they do not teach pads between the cylinders and the frame. French patent '832 teaches placing piston pads between a hydraulic cylinder and a side shift frame member. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by Abels et al. and German '292 with piston pads as taught by French patent '832 to spread the load applied to the frame over a larger area.

***Response to Amendment***

The amendments filed on March 1, 2005 have been entered into the record.

***Response to Arguments***

Applicant's arguments filed March 1, 2005 regarding claim 14 have been fully considered but they are not persuasive. In column 7 lines 25-30 Abel discloses using the fork carrying frame (105) as a means to protect the side shift operator means. Therefore the reference meets the limitations of c the claim. The rejections are hereby made final.

In response to applicant's argument against the rejection of claim 21 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., moving the shoes to the center of the side shift frame) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim merely states that the shoes move proximate to the center of the side shift frame. Further applicant argues that the references do not teach moving the shoes to the outside of the side shift frame, Figure 4 of the Bolzoni reference clearly shows this limitation. As such the claim is finally rejected.

Applicant's arguments with respect to the other claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Fox whose telephone number is 571-272-6923. The examiner can normally be reached between 7:00-4:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached at 571-272-6607. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CAF  
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